

Appln. No. 09/876,577
Amendment dated December 16, 2005
Reply to Office Action mailed September 16, 2005

REMARKS

Reconsideration is respectfully requested.

Entry of the above amendments is courteously requested in order to place all claims in this application in allowable condition and/or to place the non-allowed claims in better condition for consideration on appeal.

Claims 1, 2, and 4 through 30 remain in this application. Claim 3 has been cancelled. No claims have been withdrawn. Claims 32 through 34 have been added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraphs 4 and 5 of the Office Action

Claims 1, 2, 4, 8 through 12, 24, and 30 have been rejected under 35 U.S.C. §102(b) as being anticipated by Henson.

Claims 5 through 7, 13 through 15, and 21 through 23 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Henson in view of Tuzhilin.

Claims 26, 28 and 30 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Henson in view of Tuzhilin, and further in view of Roberts.

Claim 1 requires, in part, "providing a description of a function capable of being implemented with the combination of at least two system elements of said system configuration selection, said description of a function being dependent upon particular capabilities of the combination of said at least two system elements of said included in said system configuration selection". Claim 9 requires "providing a description of a function capable of being implemented with the combination of at least two

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system elements of said system configuration selection, said description of a function being dependent upon particular capabilities of the combination of said at least two system elements of said included in said system configuration selection". Claim 17 requires "means for providing a description of a function capable of being implemented with the combination of at least two system elements of said system configuration selection, said description of a function being dependent upon particular capabilities of the combination of said at least two system elements of said included in said system configuration selection". Claim 31 requires "providing a description of a function capable of being implemented with the particular combination of said at least two system elements comprising said system configuration selection" and "upon receiving an updated system configuration selection, providing an updated and different description of a function capable of being implemented with said updated system configuration selection".

The portion of the Henson patent at col. 6, lines 18 through 43 that is referenced in the rejection of the Office Action states (emphasis added):

Turning now to FIG. 3 (3A, 3B, and 3C), from a system configuration options screen 70, a customer of the online store 10 can build a customer configured machine by selecting from options listed on the configuration screen 70. The pricing option module 28 includes an update price function. The update price function causes the price displayed on the configuration screen to reflect any changes made to the system options. Selection of the update price function can be accomplished by clicking on an "UPDATE PRICE" icon 72 on the configuration screen. Upon obtaining a desired configuration, a customer could then select the "ADD TO CART" icon 74 to add the configured system to the shopping cart 20 and continue shopping, as desired.

The present online store application and system provide an on-line store application which includes configuration, pricing, validation, shipment delay indication, and merchandising modules. The validation module provides validation of some form with respect to the customer built configuration. The shipment delay indicator provides the customer with any lead time warnings or shipment delays which would occur as a result of the selection of specific options. In addition, the merchandising module provides messaging, alternatively referred to herein as merchandising information or messaging, of options recommended to be selected in a

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particular configuration, including, for example, which options may be better than others.

In this portion of the Henson patent, the only discussion that is relevant to the requirements of claim 1 occurs at the end of the section, and merely indicates that "merchandising information" may be included that is directed to individual options—such as which options are recommended, and which options may be better than others. It is submitted that one of ordinary skill in the art recognizes that this discussion in Henson indicates that the Henson system simply provides recommendations regarding choices between individual options for a component, and may point out why one option for an individual component is better than another option for the individual component. It is submitted that this portion of the Henson patent does not anticipate the requirement of claim 1 that "providing a description of a function capable of being implemented with the combination of at least two system elements of said system configuration selection". In fact, it is submitted that, if anything, the Henson patent at this portion tends to lead one of ordinary skill in the art away from the requirements of claim 1, as it emphasizes describing the advantages/disadvantages of a particular option for an individual component, rather than any advantages or benefits of the combination of two system elements.

In the rejection of the Office Action that addresses the Henson system, it is stated that (emphasis added):

Note: In Figs. 3 A, 3 B and 3C Henson provides a list of configuration choices in the form of displaying various choices for selecting a Dell XPS R Minitower, Monitor, memory, hard drive, monitor, Printers, Scanners, etc., thereby prompting an user to make selections to configure and order a build-to-order computerized system. While presenting the choices, Henson also provides description of functions of the system elements.

As noted above, the Henson patent does describe a system in which the functions of various individual system elements are described, but, again, this does not provide the user with any indication of any "description of a function capable of being implemented with the combination of at least two

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system elements of said system configuration selection”, as required by claim 1. Turning to the showing in Figures 3A and 3B of Henson, it is clear to one of ordinary skill in the art that the screen of the system lists a number of components that make up the system configuration, and each type of component in the list has a window associated with it that includes a drop down menu list of different options. Significantly, some of the components in the list have associated with it a short blurb that is not specific to any of the options that are listed in the window for the component—only to the component. See, for example, the blurb associated with “Hard Drive”, which generally states “[a] larger hard drive provides more storage for your operating system, Internet files, applications, graphics and scanned images!” However, this does not provide any “description of a function capable of being implemented with the combination of at least two system elements”, as it is clearly limited to the functionality provided by that component of the system by itself. Another example is the blurb associated with “Printer”, which states “[d]on’t forget your printer! Whether you need to print your kid’s artwork or output professional quality documents, Dell has the perfect printer to meet your needs.” Again, this blurb simply points out general information about printers, but does not provide any “description of a function capable of being implemented with the combination of at least two system elements”, merely stating what the addition of one component—a printer—to the system can add for functionality. In both of these example, as well as the other blurbs associated with the other components listed in the screen in Figures 3A and 3B, the blurbs are static and do not change as the combination of components selected changes. Clearly, if the blurbs in the listing of Henson were “description of a function capable of being implemented with the combination of at least two system elements”, they would be changeable as the selected options for the different components were changed, and that does not occur here. This is also noted in connection with claim 2, which requires “providing an updated description of a function capable of being

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implemented with said updated system configuration selection", as there does not appear to be any change in these blurbs are the configuration is changed.

The text of the rejection continues (emphasis added):

Henson teaches configuring a computer system made of two or more system elements, see Figs. 3A and 3B which show configuring a computer system made of several system elements, such as Dell SPS R Minitower, Monitor, Printers, and Scanners and also provides a description of function capable of being implemented with the combination of at least two systems, that is providing function of Dell Minitower as to deliver tremendous speed to high end applications, for Printers for being capable to print the kid's artwork or output professional quality documents and for scanners to be able to turn hardcopies of photographs and graphics into digital files, etc. This is in line with the applicant's invention as disclosed in Fig.5 A and page 5, lines 13-18 which show selecting two system elements as a printer and a camera and displaying the description of function of each element, that the capabilities of the printer and camera separately for the combined system including printer and camera. Also, see FIG.5 and col.9, lines 9-25)

It appears that this portion of the rejection is referring to the generalized statement in the heading of the screen in Figure 3A that "Built with high performance and reliability in mind, the Dell Dimension XPS R series use the latest in technology to deliver the tremendous speed your high-end applications are craving". However, this statement, which basically amounts to advertising puffery that appears to apply to any and configurations of the system, does not "provid[e] a description of a function capable of being implemented with the combination of at least two system elements" that is dependent upon any combination of system elements that is received, and there is nothing in the Henson patent that suggests that this generalized puffery is ever changed based upon the configuration selected.

It is therefore submitted that the cited patents, and especially the allegedly obvious combination of Henson, Tuzhilin, and Roberts set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 1, 9, 17 and 31. Further, the claims that depend from claims 1, 9, 17 and 31, also include the

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requirements discussed above and therefore are also submitted to be in condition for allowance.

With respect to claim 2, which requires "receiving an updated system configuration selection" and "providing an updated description of a function capable of being implemented with said updated system configuration selection", the assertion in the rejection of the Office Action that the "price and functions" of the system are "updated" when the user clicks on the "UPDATE PRICE" button is not supported by the disclosure of Henson. While the price may be updated (which is not a "description of a *function*") upon clicking on this button, there is nothing to indicate that any of the functional descriptions of the individual components changes in any way. While it is asserted that "any changes in the options would inherently show descriptions corresponding to the changed options", it is submitted that 1) there is no evidence in the Henson patent that these descriptions of the components change with a selection of a different component option, and 2) the "descriptions" associated with each of the components are so general in nature that there is no change needed in these descriptions based upon the change in the option selected—the "descriptions" are not specific to any one option selected for a component. It appears that the statements in the rejection are based upon speculation as to what the Henson system *might* do when the "UPDATE PRICE" button is clicked, as there is no disclosure in the Henson patent which would suggest that the blurbs associated with each of the components, or even with the "Dell Dimension XPS R" system in general, are "updated" to provide "an updated description of a function capable of being implemented with said updated system configuration selection". In fact, it is submitted that the figures and discussion in the Henson patent are more likely to suggest to one of ordinary skill in the art that the blurbs are *not* updated when the price is updated.

Claim 4 requires "wherein at least one of said available system elements in said list of configuration choices being represented by an icon",

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and the rejection of the Office Action alleges that this feature of the claimed invention is disclosed in Figure 5 and in col. 9, lines 9 through 25, which state:

With reference again to the configurator, the view module 30 includes an "all option" configurator view. That is, an ability to change from a standard view 70 (as shown in FIG. 3) to an "all option" view 90 (as shown in FIG. 5) is provided. The standard view of the online configurator is where system options 77 are presented via "drop-down" selection boxes and only the currently selected option is displayed. The standard view is preferably the default display, i.e., displayed without a shopper action. However, selection of the standard view may be accomplished via selection of the standard view selection button 96 (FIG. 3) The "all option" configurator view is where all system selection options are shown at the same time. In the later view, selections are made via use of "radio buttons" 92. Activation of the "all option" configurator view is made by selection of the appropriate view selection button 94 (FIG. 5).

However, contrary to the contention in the rejection that this portion of Henson shows the claimed "icon", it is submitted that the discussion here only mentions associating a radio button with each of the options. Since the radio button is the same for all of the options listed, with no differentiation between them (see Figure 5), it is submitted that this portion of Henson does would not lead one of ordinary skill in the art to the requirement of claim 4 of "at least one of said available system elements in said list of configuration choices being *represented by an icon*".

Withdrawal of the §102(b) and §103(a) rejections of claims 1, 2, and 4 through 31 is therefore respectfully requested.

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CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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